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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/454,173	12/02/1999	LINDA B. VANDERWOLD	3179.01A	3447
7590	01/15/2008		EXAMINER	
JOSEPH E GERBER WEINTRAUB GENSHLEA & SPROUL 400 CAPITAL MALL ELEVENTH FLOOR SACRAMENTO, CA 95814			HAN, QI	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/454,173	VANDERWOLD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Qi Han	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 October 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 49-57 and 59-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 49-57 and 59-64 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

***Response to Amendment***

3. This communication is responsive to the applicant's amendment, RCE, and affidavits/declaration under 37 C.F.R. 1.132, all filed on 10/30/2007. The applicant(s) amended claims 49, and cancelled claim 58 (see the amendment: pages 3-4).

***Response to Arguments***

4. Applicant's arguments filed on 10/30/2007 with respect to the claim rejection under 35 USC 102 and/or 103, have been fully considered but they are not persuasive.

In response to applicant's arguments with respect to the amended claim(s) that "Lewis does not anticipate the claim as amended claim 49, or claim 63" and "these combinations of references do not render claims 49-57 and 59-64 obvious" (see Remarks/Arguments: page 7,

paragraphs 3-4), the examiner respectfully disagrees with applicant's arguments. It is noted that the claim 49 (also applied to claim 63) has been amended by including the limitation(s) of the previous dependent claim 58, which is rejected based on the combined references under 35 USC 103. It should be pointed out that the applicant's arguments only include assertion(s) but fail to provide factual evidence and/or specific analysis for showing why the combined references is not obvious, so that, the arguments is insufficient for overcoming the examiner's rejection based on the teachings of the combined references.

5. In response to applicant's Declaration filed (on 10/30/2007) and the related arguments that "objective evidence of unexpected results, commercial success, long-felt but unsolved needs, failure of others, and other factor must be considered..." (Remarks/Arguments: page 7, paragraph 5 to page last paragraph 9), the examiner respectfully disagrees with applicant's arguments, because they lack the factual evidence to show **patentable distinction** between the claimed limitations and the combined prior art teachings/disclosures. For example, as stated in rejection, the claimed limitation (in previous claim 58, now as part of claim 1) is nothing more than editing/correcting a text by using a computer and word processing functions/tools with some grammatical knowledge in a user interactive manner, based on broadest reasonable interpretation of the claim(s) in light of the specification. It is noted that LEWIS in view of KINKOPH discloses 'computer-based method/system for proofreading and correcting text, including using windows, Microsoft word (textual processor/editor), and proofreading criteria and controls (tools) with interface, (LEWIS: abstract, Figs 1-3g); and how to use Word with multiple functions/tools: including "Edit" with "Find" and "Replace" (KINKOPH: page 86-87),

“Spelling and Grammar” checking (page 90-91), “thesaurus” with “look up” list (capable of including lookup list of verb, transition, and other type of words) and “replace” with synonym (page 90-91), and “AutoCorrect” with “replace text” (page 92-93), which has all interactive capability of implementing functionality as claimed. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine LEWIS with KINKOPH by providing various word processing functions/tools with grammatical knowledge for editing/correcting text in a user interactive manner, for the purpose (motivation) of allowing a user to edit or rewrite a text with user preferred text form/style. Therefore, in this case, the examiner believes that the applicant’s Declaration and the corresponding arguments are not sufficient for overcoming the rejection based on the combined references.

For above reason(s), the rejection is sustained.

***Claim Rejections - 35 USC § 103***

6. Claims 49 and 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over LEWIS et al. (US 2002/0002459 A1) hereinafter referenced as LEWIS in view of KINKOPH (“How to Use Microsoft Office 2000”, ISBN 0-672-31522-X).

As per claim 49, LEWIS discloses ‘method and system for proofreading and correcting dictated text’ (title), comprising:

“a. inputting a text document to a computer system”, (paragraph (hereinafter referenced as p) 7, ‘text input’; Fig. 1 and p36, ‘a typical computer system’; p9, ‘dictated text contained in an electronic document (inputted text document)’);

“b. conducting error-correcting functions to achieve clarity, conciseness and reader comfort’ (p9, ‘proofread and correct dictated text’ (read on conducting error-correcting functions), ‘selecting **proofreading** criteria for identifying textual errors’; p13, ‘accepting a **user specified preference** to substitute the recommended change for the marked textual error’, (so as to achieve clarity, conciseness and reader comfort as claimed); p39, ‘perform proofreading functions on the dictated text contained in the electronic document’); and,

“c. displaying said text document in a corrected form” (Fig.3G and p11, ‘highlighting each the word contained in the electronic document’ ‘visually displaying each the highlighted word in the user interface’; p13, ‘editing each the marked textural error’, ‘display the recommended change’, which necessarily or inherently include displaying the text document in a corrected form).

LEWIS does not expressly disclose “when a noun in a prepositional phrase interposed between a sentences subject and verb is capable of action, said error correcting functions comprise making said noun the subject of said sentence, and deriving a substitute verb from what said subject does”, which is nothing more than editing/correcting a text by using a computer and word processing functions/tools with some grammatical knowledge in a user interactive manner, based on broadest reasonable interpretation of the claim(s) in light of the specification. However, the feature of rewriting a sentence by using word processing functions with some grammatical knowledge in a user interactive manner is well known in the art as evidenced by KINKOPH who discloses how to use Word with multiple functions/tools: including “Edit” with “Find” and “Replace” (page 86-87), “Spelling and Grammar” checking (page 90-91), “thesaurus” with “look up” list (capable of including lookup list of verb, transition, and other

type of words) and “replace” with synonym (page 90-91), and “AutoCorrect” with “replace text” (page 92-93), which has all interactive capability of implementing the functionality as claimed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine LEWIS with KINKOPH by providing various word processing functions/tools with grammatical knowledge for editing/correcting text in a user interactive manner, for the purpose (motivation) of allowing a user to edit or rewrite a text with user preferred text form/style.

As per **claim 62** (depending on claim 49), LEWIS in view of KINKOPH further discloses “referring to a verb lookup list”, (KINKOPH: page 86-87, disclosing how to use Word with multiple functions/tools: including “Edit” with “Find” and “Replace”; page 90-91, “Spelling and Grammar” checking, “thesaurus” with “look up” list (include verb lookup list) and “replace” with synonym; page 92-93 and “AutoCorrect” with “replace text”, which has all interactive capability of implementing the functionality as claimed).

As per **claim 63**, it recites an apparatus. The rejection is based on the same reason described for claim 49, because the claim includes the same or similar limitation(s) as claim 49, wherein, the claimed computer hardware components are included in LEWIS’ disclosure (see LEWIS: Fig. 1 and p36).

7. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over LEWIS in view of KINKOPH as applied to claim 49, and further in view of Texas Association of Counties (“Job descriptions”, May 12 1990) hereinafter referenced as R1.

As per claim 50 (depending on claim 49), even though LEWIS in view of KINKOPH discloses using proofreading criteria and grammar rules on the text (LEWIS: p9-p10) and Microsoft Word processor (LEWIS: Fig. 3G) that provides various editing (including finding, correcting and replacing) functions, LEWIS in view of KINKOPH does not **exactly** disclose that “determining whether, in said text document, “responsible” followed by a gerund is present and, if present, for each said use of “responsible” replacing “responsible” with the verb form of said gerund.” However, the feature of avoiding using some particular word/term such as “responsible” in certain text is well known in the art as evidenced by R1, which discloses that ‘the term “responsible for” should not be used in listing the essential job function” because it ‘is a vague term’ and does not give entailed duty; instead, ‘job duty should begin with an action verb’ (R1: page 2, sub-section D). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify LEWIS in view of KINKOPH by providing an additional criteria/rule to use action verb instead of term “responsible for” for job duty related text, as taught by R1, for the purpose (motivation) of avoiding the vague term and providing clear indication of entailed duty in the text (R1: page 2, sub-section D).

In another view of disclosure of LEWIS and KINKOPH, LEWIS in view of KINKOPH teaches using proofreading criteria and grammar rules on the text (LEWIS: p9-p10) and Microsoft Word (LEWIS: Fig. 3G) that provides various word processing functions, which inherently include editing functions of “Find” and “Replace” (under “Edit” of the menu bar), correction functions of “spelling and grammar” and “autocorrect” (under “Tools” of the menu bar, which allow user to specify certain correcting/replacing criteria or rules), and other related functions and options. Therefore, it would have been obvious to one of ordinary skill in the art at

the time the invention was made to combine teachings of LEWIS in view KINKOPH by using proofreading criteria and grammar rules, and various Microsoft Word editing/correcting functions stated above, to find, correct and/or replace any user specified term (including word "responsible"), for the purpose (motivation) of accepting a user specified preference (LEWIS: abstract). This means that combining teachings of LEWIS in view KINKOPH can also satisfy the claimed limitation.

In addition, in light of the specification, the claimed features can be broadly interpreted as a user interactively conducts editing/correcting functions (features) with a computer and word processing tools (such as Microsoft Word), so that LEWIS in view KINKOPH, providing functionalities of editing, correcting, replacing, suggesting and displaying in an interactive manner (such as using Microsoft Word), has capability of implementing the claimed features.

8. Claims 51-52 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over LEWIS in view of KINKOPH as applied to claim 49, and further in view of MARTIN ("Developing/Revising Detention Facility Policies and Procedures", June 1996).

As per **claim 51** (depending on claim 49), even though LEWIS discloses using proofreading criteria and grammar rules on the text (p9-p10) and Microsoft Word processor (Fig. 3G) that inherently provides various editing (including finding, correcting and replacing) functions, LEWIS in view of KINKOPH does not **exactly** disclose that "determining whether, in said text document, "It" is present as the first word of a sentence and, if present, for each said sentence, replacing the word "It" with words describing to whom or to what "It" refers" However, the feature of avoiding using a particular word/term such as "It" at starting sentence is

well known in the art as evidenced by MARTIN who discloses ‘writing style checklist’ (Appendix C) and teaches to ‘avoid starting sentences with “It is,” “There is,” “There are”, which usually can be changed to eliminate the extra words, and provides examples (page 22, section of “Mechanics”). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify LEWIS in view of KINKOPH by providing criteria/rule to change/replace certain term at starting sentences, such as “It is”, “There is/are”, as taught by MARTIN, for the purpose (motivation) of following guide of the writing style checklist and using simple word and eliminating extra words (MARTIN: pages 21-22).

In another view of the disclosure LEWIS and KINKOPH, LEWIS in view of KINKOPH teaches using proofreading criteria and grammar rules on the text (LEWIS: p9-p10) and Microsoft Word (Fig. 3G) that provides various word processing functions, which inherently include editing functions of “Find” and “Replace” (under “Edit” of the menu bar), correction functions of “spelling and grammar” and “autocorrect” (under “Tools” of the menu bar, which allow user to specify certain correcting/replacing criteria or rules), and other related functions and options. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teachings of LEWIS in view of KINKOPH by using proofreading criteria and grammar rules, and various Microsoft Word editing/correcting functions stated above, to find, correct and/or replace any user specified term (including word “responsible”), for the purpose (motivation) of accepting a user specified preference (LEWIS: abstract). This means that combining teachings of LEWIS in view of KINKOPH can also satisfy the claimed limitation.

In addition, in light of the specification, the claimed features can be broadly interpreted as a user interactively conducts editing/correcting functions (features) with a computer and word processing tools (such as Microsoft Word), so that, the combined system of LEWIS in view of KINKOPH, providing functionalities of editing, correcting, replacing, suggesting and displaying in an interactive manner (such as using Microsoft Word), has capability of implementing the claimed features.

As per **claim 52** (depending on claim 49), the rejection is based on the same reason described for claim 51, because the rejection for claim 51 covers the same or similar limitation(s) as claim 52.

As per **claim 61** (depending on claim 49), the rejection is based on the same reason described for claims 49 and 51, because the rejection for claims 49 and 51 covers the same or similar limitation as claim 61.

9. Claims 53-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over LEWIS in view of KINKOPH as applied to claim 49, and further in view of SARAKI et al. (US 5,903858) hereinafter referenced as SARAKI.

As per **claim 53** (depending on claim 49), even though LEWIS in view of KINKOPH discloses using proofreading criteria and grammar rules on the text (LEWIS: p9-p10) and Microsoft Word (LEWIS: Fig. 3G) that inherently provides various word processing functions (such as finding, correcting and replacing), including the optional function to trigger a condition of “successive prepositional phrases (more than three)” (see Microsoft Word: “Tools” in menu bar > “options...” in the menu > “Spelling & Grammar” tab > “Settings...” button), which is

read on the claimed condition “when said sentence includes three or more consecutive prepositional phrases”, LEWIS in view of KINKOPH does not expressly disclose “moving one of said prepositional phrases to the beginning of a sentence”. However, the feature of moving prepositional phrase to a different position including the beginning of a sentence, is well known in the art as evidenced by SARAKI who discloses ‘translation machine for editing an original text by rewriting the same and translating the rewrote one’ (title), comprising multiple levels of analysis modules and ‘rewriting rules’ (col. 9-14), and teaches that ‘the inserted adverbial clause (including prepositional phrase) is moved to the beginning of the sentence’ and ‘the word order of ...the preposition phrase is changed’ (col. 14, lines 29-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify LEWIS in view of KINKOPH by providing changing the word order of a preposition phrase in a sentence, as taught by SARAKI, for the purpose (motivation) of rewriting or editing the text to a simple text based on rewriting rules (SARAKI: abstract).

In another view of disclosure LEWIS and KINKOPH, LEWIS in view of KINKOPH teaches using proofreading criteria and grammar rules on the text (p9-p10) and Microsoft Word (Fig. 3G) that inherently provides various word processing functions, including editing functions of “Find” and “Replace”, correction functions of “Spelling and Grammar”, “Autocorrect” and setting a trigger of “successive prepositional phrases”, as stated above, which allow user to specify testing/correcting/replacing criteria or rules. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teachings of LEWIS in view of KINKOPH by using proofreading criteria and grammar rules, and various Microsoft Word processing functions/features, to test, find, correct and/or rewrite a user

specified condition or term (such as condition of “successive prepositional phrases”), for the purpose (motivation) of accepting a user specified preference (LEWIS: abstract), particularly in an environment of requiring highly interactive and/or subjective actions from user. This means that the combined system by LEWIS in view of KINKOPH also has capability of implementing functionality as claimed.

As per **claim 54** (depending on claim 53), the rejection is based on the same reason described for claim 53, because the rejection for claim 53 covers the same or similar limitation(s) as claim 54, wherein the teaching that ‘the word order of ...the preposition phrase is changed’ (SARAKI: col. 14, lines 29-34) is applicable to move suitable “location-expressing prepositional phrase” as claimed.

As per **claim 55** (depending on claim 49), the rejection is based on the same reason described for claim 53, because the rejection for claim 53 covers the same or similar limitation(s) as claim 55. In addition, SARAK discloses that using ‘the first aspect...’ replace ‘according to one aspect ...’ (SARAKI: col. 14, lines 57-61), which further suggests that the combined teachings provide capability of implementing functionality as claimed.

As per **claim 56** (depending on claim 49), LEWIS in view of KINKOPH does not exactly disclose that “when a sentence includes both a weak verb and a gerund, said error-correcting functions comprise replacing said weak verb with the verb form of said gerund”. However, the feature of replacing said weak verb with the verb form of said gerund is well known in the art as evidenced by SARAKI who discloses ‘translation machine for editing an original text by rewriting the same and translating the rewrote one’ (title), comprising multiple levels of analysis modules and ‘rewriting rules’ (col. 9-14), recognizing syntax component, such as ‘gerund’ and

ing-form of verb, and providing the corresponding rewriting rules (col. 10, line 12 and col. 11, lines 28-47), which suggests that the system has capability of implementing functionality as claimed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify LEWIS in view of KINKOPH by providing analyzing sentence structure and rewriting rules, including processing gerund and ing-form of verbs, as taught by SARAKI, for the purpose (motivation) of rewriting or editing the text to a simple text based on a rewriting rule (SARAKI: abstract).

As per **claim 57** (depending on claim 56), LEWIS in view of KINKOPH and SARAKI further discloses “referring to a verb lookup list”, (KINKOPH: page 86-87, disclosing how to use Word with multiple functions/tools: including “Edit” with “Find” and “Replace”; page 90-91, “Spelling and Grammar” checking, “thesaurus” with “look up” list (include verb lookup list) and “replace” with synonym; page 92-93 and “AutoCorrect” with “replace text”, which has all interactive capability of implementing the functionality as claimed).

10. Claims 59-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over LEWIS in view of KINKOPH as applied to claim 49, and further in view of JAMES et al. (“Writing an Speaking for Excellence”, ISBN 0867209356) hereinafter referenced as JAMES.

As per **claim 59** (depending on claim 49), LEWIS in view of KINKOPH does not expressly disclose “when a transition word is between a sentence’s subject and verb, said error-correcting functions comprise moving said transition word to the beginning of said sentence”. However, the feature is well known in the art as evidenced by JAMES who teaches better writing with grammatical knowledge including using transitional word(s) in the beginning of

the sentence (page 31, paragraph 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine LEWIS in view of KINKOPH by providing word processing functions for editing/correcting text in a user interactive manner and using some grammatical knowledge, such as using transitional word(s) in the beginning of the sentence, as taught by JAMES, for the purpose (motivation) of allowing a user to edit or rewrite a text with user preferred text form/style.

As per **claim 60** (depending on claim 59), LEWIS in view of KINKOPH and JAMES further discloses “referring to a verb lookup list”, (KINKOPH: page 86-87, disclosing how to use Word with multiple functions/tools: including “Edit” with “Find” and “Replace”; page 90-91, “Spelling and Grammar” checking, “thesaurus” with “look up” list (include verb lookup list) and “replace” with synonym; page 92-93 and “AutoCorrect” with “replace text”, which has all interactive capability of implementing the functionality as claimed).

11. Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over LEWIS in view of KINKOPH, R1, MARTIN, SARAKI, JAMES.

As per **claim 64** (depending on claim 49), the rejection is based on the same reason described for claims 50-53, 56, 59 and 61, because the claims recites the same or similar limitations as claims 50-53, 56, 59 and 61 and it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify LEWIS’ Microsoft Word based editor/processor by combining using various editing functions with different grammatical and/or semantic knowledge from the multiple references, for the purpose (motivation) of allowing user to select a preferred form/style for correcting/rewriting a text.

***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qi Han whose telephone numbers is (571) 272-7604. The examiner can normally be reached on Monday through Thursday from 9:00 a.m. to 7:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil, can be reached on (571) 272-7602.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Inquiries regarding the status of submissions relating to an application or questions on the Private PAIR system should be directed to the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: [ebc@uspto.gov](mailto:ebc@uspto.gov). For general information about the PAIR system, see <http://pair-direct.uspto.gov>.

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January 10, 2008

 1/10/08